



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,140	06/29/2000	Richard L. Alfvn	80052F-P	7068

1333 7590 12/18/2002

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,140

Applicant(s)

ALFVIN ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Original claims 1-16 have been examined. The rejections are stated below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4, which claims 6 and 7 refer to, recites placing the order by "completing and returning a paper order form" where as claims 6 and 7 recite the limitations of "placing an order by phone" and "placing an on-line order via the Internet". If claims 6 and 7 are supposed to be dependent on claim 3 instead of claim 4, then a correction is required. In the analysis of claims 6 and 7 below it is assumed that these claims are dependent on claim 3. If this assumption is incorrect then a statement to that effect is required in reply to this office action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeley et al (US Patent 5893037) in view of Kolling et al (US Patent 6385595 B1).

With reference to claims 1 and 9, Reelee teaches a method and system respectively of managing digital images captured by a customer using a combined portable telecommunications and digital image capture device, said method comprising: a telecommunication service provider providing a telecommunication service to a customer (See Reelee Column 1 lines 56-59) and providing a data base for receiving and storing said digital images from said customer using said combined telecommunications device to transmit said digital images to said service provider (See Reelee Column 5 lines 25-43).

Reelee fails to explicitly teach the steps of telecommunications service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement.

Kolling teaches the steps of the steps of telecommunications service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period (See Kolling Column 9 lines 6-8) and providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement (See Kolling Column 9 line 53 – Column 10 line 9, Column 18 line 64-65, Column 19 lines 9-15 and lines 43-45). The enclosures are interpreted to include a visual representation of said captured images.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Kolling to the invention of Reelee. The combination of the disclosures taken as a whole suggests that users would have benefited from time saved in managing both the transactions at the same time.

Art Unit: 3624

With reference to claim 2, Reele teaches a method of claim 1 comprising the further step of editing of said digital images prior to transmitting said images to said service provider. (See Reele Column 5 lines 12-17).

With reference to claim 12, Reele teaches a system of claim 9 wherein said telecommunication services comprise telephone services. (See Reele Column 1 lines 56-59)

With reference to claim 13, Reele teaches a system of claim 9 wherein said portable combined telecommunication and image capture device comprises a combined cellular phone and a digital camera. (See Reele Abstract)

With reference to claim 14, Reele teaches a system of claim 9 wherein said portable combined telecommunication and image capture device includes a selection device for editing of said digital images prior to transmitting said images to said data base. (See Reele Column 5 lines 12-17).

With reference to claims 10 and 11, Reele teaches a system of claim 9 as discussed above.

Reele fails to teach the steps wherein the visual representation is an electronic display and a hard copy print.

Kolling teaches the steps wherein the visual representation is an electronic display (See Kolling Column 16 lines 48-62) and a hard copy print (See Kolling Column 18 lines 43-48).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Kolling to the invention of Reele. The combination of the disclosures taken as a whole suggests that users would benefit from having the speed and efficiency of an electronic display and the security and convenience provided by a hard copy.

Art Unit: 3624

With reference to claim 8, Reele teaches a method of claim 1 as discussed above.

Reele fails to teach the step providing one combined billing for multiple products or services.

Kolling teaches the step of providing one combined billing for multiple products or services. (See Kolling Figure 12)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Kolling to the invention of Reele. The combination of the disclosures taken as a whole suggests that users would benefit from the time saved in making one payment (instead of multiple separate payments) and from being able to conveniently keep track of multiple expenses.

6. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reele et al (US Patent 5893037) in view of Kolling et al (US Patent 6385595 B1) and further in view of Enomoto et al (US Patent 5974401).

With reference to claim 3, Reele and Kolling teach a method of claim 1 as discussed above.

Reele and Kolling fail to teach the step of ordering photofinishing goods and/or services with respect to said images included in said visual representation.

Enomoto teaches the step of ordering photofinishing goods and/or services with respect to said images included in said visual representation. (See Enomoto claim 1)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Kolling and Enomoto to the invention of Reele. The

Art Unit: 3624

combination of the disclosures taken as a whole suggests that users would benefit from the time saved by conducting all the transaction at the same time.

With reference to claims 6 and 7 it is assumed that the applicant had meant to refer its dependency on claim 3 instead of claim 4.

With reference to claim 7, Enomoto discloses the step of placing an on-line order via the Internet. (See Enomoto Column 3 lines 13-30). The combination of teachings of Enomoto and Kolling to the invention of Reelee suggests that users would have benefited from the time saved by conducting all the transaction at the same time and by reducing the lead-time for an order because of the efficiencies offered by the Internet.

7. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reelee et al (US Patent 5893037) in view of Kolling et al (US Patent 6385595 B1) and Enomoto et al (US Patent 5974401) and further in view of Loeb et al (US Patent 6014641).

With reference to claims 4-6, Reelee, Kolling and Enomoto teach a method of claim 3 as discussed above.

Reelee, Kolling and Enomoto fail to teach the step of ordering using a paper order form and a telephone and in the case of a paper order form returning the order form with the payment for telecommunication service.

Loeb teaches the step of ordering using a paper order form (See Loeb Column 4 lines 32-36) and a telephone (See Loeb Column 4 lines 37-40). Official notice is taken that the step of returning an order form with a payment for an invoice is old and well known in the art. This step saves money spent in mailing and also speeds up the ordering process.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Kolling, Enomoto and Loeb to the invention of Reelee. The combination of the disclosures taken as a whole suggests that users would benefit from the money saved in mailing (compared to mailing the invoice and the order separately) and also boosts the confidence of users who do not trust the privacy offered by the electronic media.

8. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al (US Patent 6385595 B1) in view of Loeb et al (US Patent 6014641).

With reference to claims 15 and 16, Kolling teaches the steps of the steps of telecommunications service provider forwarding a periodic statement for services provided to said customer for a predetermined time period (See Kolling Column 9 lines 6-8) and providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement (See Kolling Figure 12, Column 9 line 53 – Column 10 line 9, Column 18 line 64-65, Column 19 lines 9-15 and lines 43-45). The services are interpreted to include telecommunications and imaging services and the enclosures are interpreted to include a visual representation of said captured images and an order form.

Kolling fails to explicitly teach the step of ordering using paper forms with perforations separating portions of the forms.

Loeb teaches the step of ordering using paper forms (See Loeb Column 4 lines 32-36). Using perforations to separate portions of an invoice and/or and order form are old and well known in the art. Perforations help the user easily separate different portions of a statement or form and mail the ones that are relevant to that user.

Art Unit: 3624

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teachings of Loeb to the invention of Kolling. The combination of the disclosures taken as a whole suggests that users would benefit from being able to easily separate the invoice and the order form from the rest of the document and mail them together thereby also saving mailing expenses.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Goldstein et al (US Patent 2002/0154329 A1) (October 24, 2002) System and Method for Efficient Transfer of Image Data to a Service Provider

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
December 14, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600